

### **REMARKS**

Applicants' representative thanks the Examiner for the courtesies extended during the phone conference on February 4, 2009, with Francis Dunn. During the conference, there was discussion regarding proposed amendments to claims 1, 14-17, 19, and 20 to overcome objections to the claims and rejections under 35 U.S.C. §§ 101 and 112. The Examiner indicated that the proposed amendments would overcome the respective objections and rejections of the subject claims, and the subject claims would be allowable.

Applicants' representative also thanks the Examiner for indicating, in the Office Action dated December 11, 2008, that the subject claims 1-20 contain allowable subject matter, and claims 1-13 and 20 would be allowable if amended to overcome the rejection under 35 U.S.C. § 112 and the respective objections, and claims 14-19 would be allowable if amended to overcome the rejection under 35 U.S.C. § 101 and the objection to claim 14. While applicants' representative believes that the subject claims are already in condition for allowance, in order to expedite prosecution, amendments have been made to the subject claims, including independent claims 1, 14, and 20, in view of the suggestions of the Examiner with regard to overcoming the respective objections and rejections of the subject claims.

Claims 1-20 are currently pending in the subject application and are presently under consideration. Claims 1, 14-17, 19, and 20 have been amended as shown on pages 2-5 of the Reply. No new matter has been added.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

#### **I. Objection To The Claims**

Claims 1, 14, and 20 stand objected to due to various informalities. Withdrawal of the respective objections is respectfully requested in view of the amendments to these claims herein.

#### **II. Rejection of Claims 14-19 Under 35 U.S.C § 101**

Claims 14-19 stand rejected under 35 U.S.C § 101 on the grounds that the subject claims are directed to non-statutory subject matter. The claimed subject matter, as recited in claims 14-19, produces a useful, concrete, and tangible result and is directed to statutory subject matter in

accordance with 35 U.S.C. § 101. In determining patentability under 35 U.S.C. § 101, the machine-or-transformation test can be applied.

“The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See Benson, 409 U.S. at 70.” *In re Bilski*, \_\_\_ F.3d \_\_\_, 2007-1130, p. 24 (Fed. Cir. October 30, 2008).

The claimed subject matter satisfies the machine-or-transformation test and is in accordance with 35 U.S.C. § 101.

Independent claim 14 recites: *[a] computer-implemented method that provides a zoom window to annotate digital documents with digital ink, comprising: activating an inking region within the zoom window via an input device; generating the zoom window comprising the inking region to facilitate initiating an annotation event; scaling contents displayed in the zoom window; manually and automatically re-positioning and re-sizing, by a pen-based computer system, the zoom window and the inking region relative to at least one underlying digital document, the re-positioning and re-sizing of the zoom window and the inking region occurs at least as annotation of the at least one underlying digital document is entered in the inking region during the annotation event as a function of an amount of annotation information entered and displayed in the inking region, wherein size of the zoom window corresponds to size of the inking region; positioning the zoom window over an area of interest; navigating the zoom window after annotating the at least one underlying digital document; and terminating the annotation event after the annotation information is entered in the inking region.*

The claimed subject matter is tied to a machine and transforms an article to a different state or thing, and can produce a useful, concrete, and tangible result. The claimed subject matter is a **computer-implemented** method for providing a zoom window to annotate digital documents with digital ink, wherein the claimed subject matter employs a **pen-based computer system** to facilitate **re-positioning and re-sizing the zoom window and inking region relative to an underlying digital document(s)**. Thus, the claimed subject matter is tied to a machine – a pen-based computer system. Further, the claimed subject matter is **implemented** by a **computer**, and is therefore tied to a machine (e.g., a computer). Thus, the “machine” prong of the machine-or-transformation test is satisfied.

Furthermore, *re-positioning and re-sizing the zoom window and inking region* relative to the underlying digital document(s) is a *transformation* of the zoom window and inking region to different states or things. (See *Bilski*, \_\_\_ F.3d \_\_\_, 2007-1130, at p. 26 (electronic transformation of data into a visual depiction is sufficient to satisfy the transformation prong of the machine-or-transformation test).) Moreover, the claimed subject matter can generate a zoom window and can *scale contents* displayed in the zoom window – thus, content can be *transformed* or adjusted in scale, which causes the content to be in a *different state*. Thus, the “transformation” prong of the machine-or-transformation test also is satisfied. In addition, the claimed subject matter produces a useful, concrete, and tangible result, as the claimed subject matter is a method that facilitates annotating digital documents with digital ink.

In view of at least the foregoing, the subject claims, claims 14-19 are in accordance with 35 U.S.C. § 101. Therefore, it is believed that the subject claims are in condition for allowance.

### **III. Rejection of Claims 1-13 and 20 Under 35 U.S.C § 112**

Claims 1-13 and 20 stand rejected under 35 U.S.C § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is requested that this rejection be withdrawn for at least the following reason. The subject claims particularly point out and distinctly claim the subject matter which the applicants regard as their invention. 35 U.S.C § 112, second paragraph, provides: “[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.”

Independent claim 1, as amended, recites: *[a] computer system that facilitates free form digital inking, comprising: a pen-based microprocessor device and an application program, the application program is recorded on a computer-readable medium and capable of execution by a computer, the application program comprising: an input device for activating an inking region within a zoom window; an annotation management component that generates the zoom window comprising the inking region for an underlying digital document; and a navigation component that manually and automatically re-positions and re-sizes the zoom window and the inking region relative to the digital document, the re-position and re-size of the zoom window and the inking region occurs at least as an annotation of the digital document is entered in the inking region during an annotation event based at least in part on an amount of annotation*

*information entered and displayed in the inking region, the size of the zoom window corresponds to the size of the inking region.*

The claimed subject matter is a **computer system** that facilitates free form digital inking. The claimed subject matter comprises a **pen-based microprocessor device** and an **application program**. The application program **is recorded on a computer-readable medium and capable of execution by a computer**, and comprises **an input device for activating an inking region within a zoom window, an annotation management component, and a navigation component** that are employed to facilitate free form digital inking of an underlying digital document(s). As can be readily seen, the claimed subject matter, including the pen-based microprocessor device, the input device for activating an inking region within a zoom window, and at least one underlying digital document, particularly points out and distinctly claims the subject matter which applicants regard as the subject innovation. Thus, the claimed subject matter is in accordance with 35 U.S.C § 112, second paragraph.

Further, independent claim 20, as amended, recites: ***[a] computer system that facilitates electronic document annotating, comprising: a pen-based microprocessor device; means for activating an inking region within an annotation window; means for generating the annotation window comprising the inking region for an underlying electronic document; means for defining a location of the annotation window; means for magnifying contents of the annotation window; means for employing the annotation window to annotate the underlying electronic document; and means for manual and automatic re-positioning and re-sizing of the annotation window and the inking region relative to the underlying electronic document, the re-positioning and re-sizing of the annotation window and the inking region occurs at least as an annotation of the underlying electronic document is entered in the inking region during an annotation event based at least in part on a quantity of annotation information entered and displayed in the inking region, wherein size of the annotation window corresponds to size of the inking region.***

For at least reasons similar to the reasons stated herein with regard to independent claim 1, independent claim 20 is in accordance with 35 U.S.C § 112, second paragraph, as the claimed subject matter particularly points out and distinctly claims the subject matter which applicants regard as their invention. For instance, the claimed subject matter is a **computer system** that facilitates annotating electronic documents. The claimed subject matter contains a **pen-based**

*microprocessor device*, which can be employed to facilitate annotating an underlying electronic document(s). To facilitate annotating an underlying electronic document(s), the claimed subject matter can *manually and automatically re-position and re-size the annotation window and the inking region relative to the underlying electronic document(s)*, while the annotation is being entered in the inking region. The claimed subject matter further contains a *means for activating an inking region within an annotation window*, which can facilitate free form digital inking of the underlying electronic document(s).

In view of at least the foregoing, the subject claims, independent claims 1 and 20 (and associated dependent claims 2-13) are in accordance with 35 U.S.C. § 112, second paragraph. Therefore, it is believed that the subject claims are in condition for allowance, and withdrawal of this rejection is respectfully requested.

**CONCLUSION**

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP592US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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